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In this respect it is no different from the Chou reference cited in the previous rejection based on another patent to Chou.

It is noteworthy that there is no teaching of toner particles that are comprised of a polymer and metal dispersed in the polymer (even without any requirement that the metal be in flake form). In Chou, the metal is separate from the organosol, which might be stretched to be (but probably should not be) considered "toner particles."

Ray describes the use of metal flake material in toners. However, Ray, in describing the various processes for producing such toners makes clear that two of the processes, namely extrusion and mixing in a high shear mixer destroy the flakes, so that the resulting toner does not include flakes any more.

The third process, namely spray drying the toner particles with toner resin, to the extent that it is enabling, appears to result in toner particles having a single flake and not "metal flakes dispersed in the polymer" of the toner particles.

The Ray patent teaches against the use of high shear mixing (col. 7, lines 46-50).

The examples given do not include the spray drying method. Applicants submit that not only do the spray dried toner particles not meet the claim (as indicated above), but that the Ray patent does not provide an enabling disclosure of how to make such particles. Thus, Ray remains a theoretical teaching of a desirable feature, without teaching how to produce the toner particles.

The Examiner indicates that it would have been obvious to provide the flakes of Ray in the toner particles of Chou. However, on the evidence of the disclosures themselves this is not true. Chou does not describe polymer particles with metal dispersed in the polymer. Inserting Ray's "flakes" into Chou would only result in a suspension of organosol particles and separate flakes of metal. However, not only does this combination not meet the claim limitations, it would not work, since the metal particles would not remain in suspension, they would settle. This is, perhaps, the reason why Chou utilizes a *colloidal* suspension, which means very small particles.

Applicants further submit that claims 69-71 as dependents from any of claims 54-58 and 58 are further distinguished from the prior art. In particular, these claims define a liquid toner utilizing the particles. Applicants submit that the use of particles, actually containing flakes, results in a much larger particle than that usually used in liquid toners. The cited art does not teach liquid toners containing such particles. While the lack of a *prima facie* case makes it unnecessary to provide advantages of larger toner particles, applicants note that one of the advantages of liquid toner is that the particles can be made smaller. This allows for better spatial resolution than with large particles. It is unobvious to produce large particles for liquid toners. The only reason for

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providing such toners, as indicated in the disclosure, is that this is the only way to provide polymer particles with flakes dispersed therein.

Applicants note that while Ray does indicate that particle sizes of as small as 1 micron are defined, there is no teaching that this size applies to flakes. Furthermore, the examples applying to metallic components define particles sizes of 35.4 microns (example 1) and 29.7 microns (example 5). Examples 2 and 3 utilize the materials of Example 1 and example 6 utilizes the material of example 5 and example 4 does not utilize flake, even as a starting material.


Applicants submit that even if the Examiner were to find that for use in powder toner, the particles as defined in claim 54 is unpatentable, a liquid toner utilizing the large particles of Ray is neither taught nor suggested.

Thus, the Examiner's rejection fails on both its major assumptions, resulting in the lack of a *prima facie* case of obviousness. First, the combination does not result in the claimed toner. Second, even this unclaimed combination does not have a reasonable chance to be a usable toner in practice.

Kindly direct all telephone inquiries to the undersigned at 1-(877) 428-5468. Please note that this is a direct *toll free* number in the US that is answered in the undersigned's Israel office. Israel is 7 hours ahead of Washington.

In view of the above arguments, applicants submit that the application is in order for allowance. Notice to that effect is respectfully awaited.

Respectfully submitted,
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